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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 10/538,794  | 06/13/2005  | Ronald J. Craswell     | 115710-161648       | 4320             |
| 25943 7590 01/10/2011<br>Schwabe Williamson & Wyatt<br>PACWEST CENTER, SUITE 1900<br>1211 SW FIFTH AVENUE<br>PORTLAND, OR 97204 |             |                        |                     |                  |
| EXAMINER<br>DANIEL JR, WILLIE J   |             |                        |                     |                  |
| ART UNIT<br>2617  |             | PAPER NUMBER           |                     |                  |
| MAIL DATE<br>01/10/2011   |             | DELIVERY MODE<br>PAPER |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/538,794

**Applicant(s)**

CRASWELL ET AL.

**Examiner**

WILLIE J. DANIEL JR

**Art Unit**

2617

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 03 January 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Charles N. Appiah/  
Supervisory Patent Examiner, Art Unit 2617

Continuation of 11. does NOT place the application in condition for allowance because:

1. Applicant's arguments filed 03 January 2011 have been fully considered but they are not persuasive. The Examiner respectfully disagrees with applicant's arguments as the applied reference(s) provide more than adequate support and to further clarify (see the comments in this section and Final Action mailed on 02 November 2010).
  
2. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).  
  
Regarding applicant's argument of claim 1 in the par. bridging pgs. 5-6, "...fails to disclose the determine and depict recitations...teaches away...", the Examiner respectfully disagrees. Applicant has failed to interpret and appreciate the combined teachings of well-known prior art Kawamata and Herschberg that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. In particular, Kawamata discloses the language as related to the claimed feature(s) receive, with the update catalog (e.g., software group), mandatory updates (e.g., software group necessary) { (see col. 13, lines 15-23, 46-51; Figs. 7 & 18) }.  
As further support in the same field of endeavor, Herschberg discloses the language as related to the claimed feature(s) determine that a first group of the available discretionary updates (e.g., optional applications) is relevant (e.g., compatible) to the wireless device (106) which reads on the claimed "wireless computing apparatus" { (see pg. 1, [0007, lines 7-9; 0009, lines 7-13]; pg. 3, [0076]; pg. 4, [0093]; Fig. 2), where the system provides optional applications for downloading (see pg. 4, [0086, 0088]; pg. 10, [0181]; Figs. 1a & 46c) }, and that a second group of the available discretionary updates is irrelevant (e.g., not compatible including permission deny/unauthorized application) to the wireless computing apparatus (106) { (see pg. 1, [0007, lines 7-13]; pg. 4, [0092]; pg. 10, [0177-0178]), where applications that are not compatible are denied or not downloaded and where installed applications that are denied or incompatible are deleted from device (106) (see pg. 11, [0195; 0197, lines 11-15; 0198, lines 11-16; 0199, lines 6-10]) }; and depict representations of the available discretionary updates of the first group in a selectable manner to enable user control over installation of the relevant discretionary updates { (see pg. 1, [0009, lines 7-13]; pg. 10, [0181, lines 1-4]; pg. 11, [0199, lines 10-16]; Figs. 1a & 46c), where the system prompts a user to select optional applications for download }. Therefore, the combination(s) of the reference(s) Kawamata and Herschberg as addressed above more than adequately meets the claim limitations.
  
3. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).  
  
Regarding applicant's argument on pg. 6, 2nd full par., "...lack motivation to modify the automatic software distribution system...to enable user control...", the Examiner respectfully disagrees. The applied references Kawamata (see abstract) and Herschberg (see abstract) are in the same field of endeavor and well known prior art prior to the filing of the instant application. Example 1, Kawamata discloses a request from a user is transmitted { (see col. 10, lines 44-50, 61-63; col. 11, lines 58-61; col. 12, lines 27-30; Figs. 16 'ref. 1610' & 17 'ref. 1610'), where the system has a function for the user to control the request for the updating of software as well as in combination with other enhanced functionality (see col. 1, lines 31-34) }. In this case, Herschberg motivates by providing a system and method for managing application provisioning to one or more wireless devices, as taught by Herschberg (see pg. 1, [0005, lines 1-2]).
  
- See MPEP § 2144.04(III). [In *re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)...The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.)]
  
4. Regarding applicant's argument(s) of claims 2-5 and 10-12, the claims are addressed for the same reasons as set forth above and as applied above in each claim rejection.